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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/026,758	12/27/2001	Gregg A. McClelland	8350.1647-00	9791

7590 08/28/2008
Finnegan, Henderson, Farabow,
Garrett & Dunner, L.L.P.
1300 I Street, N.W.
Washington, DC 20005-3315

EXAMINER

CASCHERA, ANTONIO A

ART UNIT	PAPER NUMBER
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2628

MAIL DATE	DELIVERY MODE
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08/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/026,758	Applicant(s) MCCLELLAND ET AL.	
	Examiner Antonio A. Caschera	Art Unit 2628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-21 is/are allowed.
- 6) ☒ Claim(s) 1-14 and 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Application Status

1. In view of the appeal brief filed on 7/10/2008, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-14 and 22-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In reference to claim 1, the language of the claim raises questions as to whether the claims (claims 1 and all dependent claims, 2-7 and 25-28) are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical

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application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Specifically, newly implemented practices and procedures directed towards the analysis of claim language as per 35 U.S.C. 101 question the “method of colorizing a schematic...” as disclosed in claim 1. The above claimed process is not (1) tied to another statutory class (such as a particular apparatus) or (2) does not transform underlying subject matter to a different state or thing, Therefore the method is not a patent eligible process under 35 U.S.C. 101 and is rejected as being directed to non-statutory subject matter.

In reference to claim 8, the language of the claim raises questions as to whether the claims (claims 8 and all dependent claims, 9-14) are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Specifically, newly implemented practices and procedures directed towards the analysis of claim language as per 35 U.S.C. 101 question the antecedent basis for the claimed terminology of the "computer-readable medium" as recited in claims 8-14. The specification of the instant application does explicitly define the term, “computer-readable medium” as “Storage medium 136 may include a disk, CD ROM, or other conventional storage medium on which the colorized schematic may be stored and/or transferred to another computer for review or publication. Alternatively, colorized schematics may be transferred to another computer for review or publication by hard-wire connections, such as LAN technology, Internet connections, or wireless technology.” (see paragraph 19 of the specification). The specification does clearly suggest to one of ordinary skill in the art that such a “computer-readable medium” could be one of transmission or other propagation media form explicitly when the Applicant

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states, ““Storage medium 136 may include...or other conventional storage medium on which the colorized schematic may be stored and/or transferred to another computer for review or publication.” Therefore such terminology fails to create an appropriate manufacture under 35 U.S.C. 101 in the context of computer-related inventions and therefore requires the rejection of claims 8-14.

In reference to claim 22, the language of the claim raises questions as to whether the claims (claims 22 and all dependent claims, 23-24) are directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. Specifically, newly implemented practices and procedures directed towards the analysis of claim language as per 35 U.S.C. 101 question the “colorization module” of the claims as per the claimed “system” found in the body of claims 22 and 24. The specification provides evidence enabling one of ordinary skill in the art to reasonably interpret the “module” of the claims as software routines/modules/etc. (see). Therefore, such a claimed element is software per se, which fails to fall within a statutory category of invention and necessitates the rejection of claims 22-24. Note, claims 15-21 also recite a system however claim 15 additionally recites physical hardware device such as a “processor” a “memory” which is a physical part of a device and therefore the combination of elements can be constituted a machine within the meaning of 35 U.S.C. 101.

Allowable Subject Matter

3. Claims 15-21 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

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In reference to claim 15, the prior art of record does not explicitly disclose a colorization module configured to obtain a schematic generated from a feature-based parametric modeling module and colorize the schematic to generate a colorized schematic, in combination with the further limitations of claim 15.

In reference to claims 16-21, claims 16-21 depend upon allowable claim 15 and are therefore also deemed allowable.

References Cited

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- a. Fielding (U.S. Patent 6,556,878)
 - Fielding discloses a method of displaying an architectural plan having color keyed elements.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Antonio Caschera whose telephone number is (571) 272-7781. The examiner can normally be reached Monday-Thursday and alternate Fridays between 7:00 AM and 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kee Tung, can be reached at (571) 272-7794.

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Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

571-273-8300 (Central Fax)

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (571) 272-2600.

/Antonio A Caschera/

Examiner, Art Unit 2628

Temporary Full Signatory Authority

8/28/08